C. REMARKS/ARGUMENTS

1. Status of the Claims

Claims 1-29 are currently pending in the application. Claims 1, 14, and 17 are independent. Claims 2-13 depend on claim 1. Claims 15-16 depend on claim 14. Claims 18-29 depend on claim 17.

Claims 1, 14, 17, and have been amended. No new matter is added by the amendments to claims 1, 14, 17. Support for these amendments can be found throughout the specification, as discussed in full below.

2. Rejection of Claims 1-3, 10-15, 17-19 and 26-29 Under 35 U.S.C. § 102(e)

Claims 1-3, 10-15, 17-19 and 26-29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,371,904 by Sirimanne ("Sirimanne"). The Applicant respectfully traverses these rejections.

In response to the Examiner's rejection, Applicant has amended independent claims 1, 14, and 17.

In particular, Applicant has amended independent claim 1 to recite that the fiducial apparatus is adapted to be inserted into a non-void target region comprising tissue, that the anchoring devices are configured to anchor the fiducial apparatus within the tissue of the non-void target region, that the unanchored position permits the body portion to move within the tissue of the non-void target region, and that the anchored position secures the body portion within the tissue of the non-void target region.

Applicant has amended independent claim 14 to recite a method for anchoring a fiducial in a non-void target region that includes tissue, comprising inserting the fiducial into the tissue of the non-void target region, the fiducial having an anchoring device that anchors the fiducial within the tissue of the non-void target region, the anchoring device being held closed while being inserted into the tissue of the non-void target region. Applicant has further amended independent claim 14 to recite securing the fiducial

within the tissue of the non-void target region after the fiducial is inserted into the tissue of the non-void target region, the anchoring device opening after the fiducial has been inserted into the tissue of the non-void target region.

Applicant has amended independent claim 17 to recite means for securing the body portion within tissue of a non-void target region so that the fiducial apparatus cannot move. Applicant has also amended independent claim 17 to recite that the unanchored position (of the means for anchoring the body portion) permits the body portion to move within the tissue of the non-void target region, and that the anchored position secures the body portion within the tissue of the non-void target region.

No new matter is added by these amendments. Support for these amendments can be found throughout the specification. See e.g. Applicant's specification p. 2, lines 13-15 ("The anchored fiducial apparatus in accordance with the invention anchors itself when it is placed into the region (of tissue) so that the anchored fiducial does not move/change its location relative to the region over time"); p. 2, lines 17-20 ("Once the fiducial apparatus is inserted into the region, it may be placed into an anchored position in a state which secures/anchors the fiducial apparatus in the region (of tissue) and therefore unlikely to move and migrate over time . . . "); p. 5, lines 19-20 (". . . the anchor member is a spike that anchors itself into the target tissue"); p. 5, lines 23-26 (". . . the anchor members 42 pop out from the body portion and embed themselves into the target region so that the fiducial apparatus does not move/change position or migrate.")

Applicant submits that, unlike what is recited in Applicant's amended claims described above, the Sirimanne document is not directed to any fiducial apparatus adapted to be inserted into a non-void target region comprising tissue (as stated in amended claim 1 above), nor is the Sirimanne document directed to a method for anchoring a fiducial within the tissue of a non-void target region (as stated in amended claim 14 above). In contrast, as described in detail below with supporting citations from the Sirimanne document, Sirimanne teaches a cavity-marking device, which is inserted into a void cavity resulting from excision of lesion tissue (as opposed to being inserted

into tissue of a non-void target region), and which has a body (made of resilient material) that self-expands, upon insertion into the empty cavity, to fill up the cavity, plus a marker. Sirimanne further teaches that the cavity-marking body has at least one marker, and that after the cavity-marking device is placed within the cavity, the body degrades at a predetermined rate, leaving behind only the marker. Sirimanne thus teaches a device and method very different from what is claimed by Applicant.

Further, as discussed further below, no anchoring device connected to the body portion of a fiducial apparatus is disclosed anywhere in Sirimanne, much less any anchoring device that anchors the fiducial apparatus within any tissue of a non-void target region, and much less any anchoring device that has an unanchored position and an anchored position.

Applicant submits that at least the following limitations of amended claims 1, 14, and 17 cannot be found in the Sirimanne document:

a) one or more anchoring devices connected to the body portion and configured to anchor the fiducial apparatus within the tissue of the non-void target region (amended claim 1) / means for anchoring the body portion within tissue of a non-void target region (amended claim 17);

b) the unanchored position permitting the body portion to move within the tissue of the non-void target region (amended claims 1 and 17)

c) the anchored position securing the body portion within the tissue of the non-void target region (amended claims 1 and 17);

d) inserting the fiducial into the tissue of a non-void target region, the fiducial having an anchoring device that anchors the fiducial within the tissue of the non-void target region, the anchoring device being held closed while being inserted into the tissue of the non-void target region (amended claim 14);

and

e) securing the fiducial within the tissue of the non-void target region after the fiducial is inserted into the tissue of the non-void target region, the anchoring device

opening after the fiducial has been inserted into the tissue of the non-void target region (amended claim 14).

Regarding limitation a), nowhere in Sirimanne is there any teaching or suggestion of any anchoring device that anchors any fiducial apparatus within the tissue of a non-void target region, or any means for anchoring a body portion of a fiducial apparatus within tissue of a non-void target region.

The Examiner cites col. 2, lines 54-60 of Sirimanne as support for reference to a body portion of a fiducial apparatus to be inserted into a target region, and cites col. 5, lines 4-11 as support for reference to one or more anchoring devices connected to the body portions. However, Col. 2 lines 54-60 and col. 5, lines 4-11 of Sirimanne (which are reproduced below), nowhere in the portions of Sirimanne cited by the Examiner is any anchoring of a fiducial apparatus within the tissue of a non-void target region disclosed or suggested, much less any anchoring device connected to the body portion and configured to anchor the fiducial apparatus within tissue the non-void target region.

Instead, Sirimanne col. 2 lines 54-60 and col. 5 lines 4-11 both refer to a cavity marking device having a body (made of resilient material), the body in turn having a marker. There is no mention or hint anywhere in these quoted portions of Sirimanne, or anywhere else in Sirimanne, of any separate anchoring device that is connected to the body of a fiducial apparatus, or of any such anchoring device being configured to anchor the fiducial apparatus within the tissue of a non-void target region.

Col. 2 lines 54-60 of Sirimanne states:

> This invention relates to devices and procedures for percutaneously marking a biopsy cavity. In particular, the inventive device is a **biopsy cavity-marking body** made of a resilient, preferably bioabsorbable material having at least one preferably radiopaque or echogenic marker. The device may take on a variety of shapes and sizes tailored for the specific biopsy cavity to be filled.

As seen above, col. 2 lines 45-60 of Sirimanne describes a cavity marking device that takes on a variety of shapes and sizes tailored to fill up specific biopsy cavities. As seen above, there no mention or suggestion in col. 2, lines 45-60 of any anchoring device that is connected to the body portion of a fiducial apparatus, and anchors the fiducial apparatus within the tissue of a non-void target region. In fact, by stating that the body of the cavity-marking device is inserted into an empty cavity, then self-expands (**without help from any anchoring device connected to the body**), substantially filling the cavity, the Sirimanne document teaches away from limitation a) which requires an anchoring device that is connected to the body portion, and that anchors the body portion within the tissue of a non-void target region. See e.g. Tec Air, Inc. v. Denso Mfg. Mich. Inc., 192 F.3d 1353, 1360, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999): "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, . . . would be led in a direction divergent from the path that was taken by the applicant." (underline added).

Col. 5 lines 4-11 of Sirimanne states:

> In contrast to the marker clips as described above, the cavity marking device has the obvious advantage of marking the geometric center of a biopsy cavity. Also, unlike the marking clip which has the potential of attaching to loose tissue and moving after initial placement, the marking device self-expands upon insertion into the cavity, thus providing resistance against the walls of the cavity thereby anchoring itself within the cavity.

Again, col. 5 lines 4-11 of Sirimanne teaches away from an anchoring device that is connected to the body portion of the fiducial apparatus and that anchors the body portion within the tissue of a non-void target region, by stating that the cavity marking device in Sirimanne self-expands upon insertion into the cavity, and anchors **itself** (without any anchoring device connected to the resilient body that self-expands) within an empty cavity (as opposed to anchoring itself within tissue of a non-void region).

Regarding limitation b), there is no teaching or suggestion anywhere in Sirimanne of any anchoring device (or a means for anchoring a body portion of a

fiducial apparatus) having an unanchored position that permits the body portion to move within the tissue of the non-void target region. As explained above, Sirimanne fails to disclose any anchoring device that anchors a fiducial apparatus within tissue of a non-void target region, in the first place. In contrast, Sirimanne discloses a cavity marking device comprised of a body made of resilient material that self-expands to fill up the cavity. See e.g. Sirimanne, Col. 2, lines 54-60 (" "); Col. 3, lines 38-39 (" "). No separate anchoring device for the body is mentioned or even hinted at, anywhere in Sirimanne, much less an anchoring device which, in an unanchored position, permits a body portion of the fiducial apparatus to move within the tissue of a non-void target region. In fact, by stating that the body of the cavity-marking device is inserted into an empty cavity, then self-expands, substantially filling the cavity, the Sirimanne document teaches away from limitations b), which recites an anchoring device that is connected to the body portion, and that

It is well known that a document anticipates a claim only if the document discloses all the elements and limitations of the claim. If even one element or limitation of the claim is missing, a § 102 rejection fails. See e.g. Kalman v. Kimberly-Clark, 713 F.2d 760, 771, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Also, anticipation requires the disclosure in a single document of each element of the claim under consideration. See In re Dillon, 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990)(en banc), cert denied, 500 U.S. 904 (1991). Applicant respectfully submits that Sirimanne does not anticipate the invention as recited in amended independent claims 1, 14, and 17, because Sirimanne does not teach or suggest at least the above-discussed limitations of these claims.

For these reasons, Applicant submits that amended claims 1, 14, and 17 are not anticipated by the Sirimanne document, and are allowable.

If an independent claim is not anticipated under 35 U.S.C. 102(e) by a document, then any claim depending therefrom is also not anticipated by that document.

Claims 2-3 and 10-13 all depend on claim 1, and therefore include all the limitations of claim 1. For all the reasons discussed above, amended independent claim 1 is not anticipated by Sirimanne under 35 U.S.C. 102(e). Accordingly, it follows that claims 2-3 and 10-13 (all depending from claim 1) are also not anticipated by Sirimanne under 35 U.S.C. 102(e).

Claim 15 depends on claim 14, and therefore include all the limitations of claim 14. For all the reasons discussed above, amended independent claim 14 is not anticipated by Sirimanne under 35 U.S.C. §102(e). Accordingly, it follows that claim 15 (depending from claim 14) is also not anticipated by Sirimanne under 35 U.S.C. 102(e).

Claims 18-19 and 26-29 all depend on claim 17, and therefore include all the limitations of claim 17. For all the reasons discussed above, amended independent claim 1 is not anticipated by Sirimanne under 35 U.S.C. §102(e). Accordingly, it follows that claims 18-19 and 26-29 (all depending from claim 17) are also not anticipated by Sirimanne under 35 U.S.C. §102(e).

For these reasons, it is submitted that claims 1-3, 10-15, 17-19, and 26-29 are allowable. Applicant respectfully requests that the 35 U.S.C. §102(e) rejection of claims 1-3, 10-15, 17-19, and 26-29 be withdrawn.

3. Rejection of Claims 4-6 and 20-22 Under 35 U.S.C. § 103(a)

Claims 4-6 and 20-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Sirimanne document in view of U.S. Pat. No. 5,562,641 to Flomenblit et al. ("Flomenblit") . The Applicant respectfully traverses these rejections.

Claims 4-6 depend on independent claim 1. Claims 20-22 depend on independent claim 17. Applicant submits that claims 4-6 and 20-22 are not obvious under 35 U.S.C. §103 over Sirimanne in view of Flomenblit, because 1) amended independent claims 1 and 17, upon which claims 4-6 and 20-22 depend, are not obvious under 35 U.S.C. § 103 over Sirimanne in view of Flomenblit, and 2) if any

independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious (see e.g. MPEP 2143.03).

A. Amended Independent Claims 1 and 17 Are Not Obvious Under 35 U.S.C. § 103 Over Sirimanne in View of Flomenblit

Applicant submits that, for reasons discussed below, a *prima facie* case of obviousness of amended independent claims 1 and 17 has not been established and therefore that there is no proper basis for a 35 U.S.C. § 103 rejection of claims 1 and 17. See MPEP 2142 ("The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.")

In order to establish a *prima facie* case of obviousness, a rejection must satisfy, *inter alia*, at least the following conditions:

1) The prior art reference(s) must teach or suggest all of the elements and limitations recited in the claims; and

2) There must be some suggestion, teaching, or motivation to combine the references on which the rejection is based.

See MPEP 2142.

1) The Cited Documents (Sirimanne and Flomenblit), Either Alone or in Combination, Fail to Teach or Suggest All of the Elements of Amended Independent Claims 1 and 17

Applicant submits that neither Sirimanne nor Flomenblit, either alone or in combination, teaches or suggests all of the elements and limitations recited in the amended independent claims 1 and 17.

Sirimanne

For all of the reasons discussed in detail in conjunction with section 2 above, Applicant submits that Sirimanne fails to teach or suggest at least the following limitations of amended independent claims 1 and 17:

a) one or more anchoring devices connected to the body portion and configured to

anchor the fiducial apparatus within the tissue of the non-void target region (amended claim 1) / means for anchoring the body portion within tissue of a non-void target region (amended claim 17);

b) the unanchored position permitting the body portion to move within the tissue of the non-void target region (amended claims 1 and 17)

c) the anchored position securing the body portion within the tissue of the non-void target region (amended claims 1 and 17).

Flomenblit

As for Flomenblit, Applicant submits that none of the limitations of either claim 1 or claim 17 are taught or suggested in Flomenblit, nor does the Examiner state in his Office Action that Flomenblit teaches or suggests any of the limitations of amended independent claims 1 or 17.

In particular, Flomenblit neither teaches nor suggests any fiducial apparatus adapted to be inserted into a non-void target region comprising tissue, nor does Flomenblit teach or suggest that the fiducial apparatus comprises a body portion made of a material that is visible using electromagnetic radiation, nor does Flomenblit teach or suggest one or more anchoring devices connected to the body portion and configured to anchor the fiducial apparatus within the tissue of the non-void target region, each anchoring device having an unanchored position and an anchored position, the unanchored position permitting the body portion to move within the tissue of the non-void target region and the anchored position anchoring the fiducial apparatus and securing the body portion within the tissue of the non-void target region. (Amended Claim 1).

Further, Flomenblit neither teaches nor suggests any fiducial apparatus comprising a body portion, and means for anchoring the body portion within tissue of a non-void target region so that the fiducial apparatus cannot move, the means for anchoring the body portion having an unanchored position and an anchored position, the unanchored position permitting the body portion to move within the tissue of the

non-void target region and the anchored position anchoring the fiducial apparatus and securing the body portion within the tissue of the non-void target region. (Amended Claim 17).

2) There is no Suggestion, Teaching, or Motivation to Combine the Documents (Sirimanne and Flomenblit) on Which the Examiner's Rejection is Based

It is well known that the cited documents themselves must suggest the desirability of making the proposed combination, in order for a *prima facie* case of obviousness to be established. MPEP §§ 2141 - 2142. In other words, the teaching or suggestion to make the claimed combination (as well as the reasonable expectation of success) must both **be found in the prior art** itself, and not based on applicant's disclosure. MPEP 2142. Also, "[*T*]*he evidence of record must identify an objective source of the motivation to combine A with B in the manner proposed.*" In Re San Su Lee, 277 F.3d 1338 (CAFC 2002). Further, *"[T]he initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done."* MPEP 2142 and In Re San Su Lee, 277 F.3d at 1338.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills,* 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) MPEP2143.01.

Applicant respectfully submits that the record does not establish the requisite motivation for combining Sirimanne (directed to a subcutaneous cavity marking device and method) with Flomenblit (directed to a two way shape memory alloy medical stent). Nowhere in the Sirimanne and/or Flomenblit documents themselves is there any suggestion of the desirability of making the proposed combination. Applicant submits that the burden of providing a suggestion of the desirability of making the proposed combination has not been met.

For all of the reasons discussed above, Applicant submits that amended independent claims 1 and 17 are not obvious under 35 U.S.C. § 103 over Sirimanne in view of Flomenblit.

B. Because Amended Independent Claims 1 and 17 Are Not Obvious Under 35 U.S.C. § 103 Over Sirimanne in View of Flomenblit, and Because Claims 4-6 and 20-22 Depend on Claims 1 and 17, Respectively, Claims 4-6 and 20-22 Are Not Obvious Under 35 U.S.C. § 103 Over Sirimanne in View of Flomenblit

It is well known that "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP 2143.03; In re Fine, 837 F.2d 1071, 2 USPQ2s 1596 (Fed. Cir. 1988).

Claims 4-6 all depend on claim 1, and therefore include all the limitations of claim 1. For all the reasons discussed above, amended independent claim 1 is nonobvious under 35 U.S.C. 103 over Sirimanne in view of Flomenblit. Accordingly, it follows that claims 4-6 (all depending from claim 1) are also nonobvious under 35 U.S.C. §103.

Claims 20-22 all depend on claim 17, and therefore include all the limitations of claim 17. For all the reasons discussed above, amended independent claim 17 is nonobvious under 35 U.S.C. 103 over Sirimanne in view of Flomenblit. Accordingly, it follows that claims 20-22 (all depending from claim 17) are also nonobvious under 35 U.S.C. §103.

For these reasons, it is submitted that claims 4-6 and 20-22 are allowable.

4. Rejection of Claims 7-9, 16, and 23-25 Under 35 U.S.C. § 103(a) Over Sirimanne In View of Foerster

Claims 7-9, 16, and 23-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Sirimanne document in view of U.S. Published Appln. No. 2004/0024304 to Foerster et al. ("Foerster"). The Applicant respectfully traverses these rejections.

Claims 7-9 depend on independent claim 1. Claim 16 depends on claim 14. Claims 23-25 depend on claim 17. Applicant submits that claims 7-9, 16, and 23-25 are not obvious under 35 U.S.C. §103 over Sirimanne in view of Foerster, because 1) amended independent claims 1, 14, and 17, upon which claims 7-9, 16, and 23-25 depend, respectively, are not obvious under 35 U.S.C. § 103 over Sirimanne in view of Foerster; and 2) if any independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious (see e.g. MPEP 2143.03).

A. Amended Independent Claims 1, 14, and 17 Are Not Obvious Under 35 U.S.C. § 103 Over Sirimanne in View of Foerster

Applicant submits that, for reasons discussed below, a *prima facie* case of obviousness of claims 1, 14, and 17 has not been established and therefore that there is no proper basis for a 35 U.S.C. § 103 rejection of claims 1, 14, and 17. See MPEP 2142 ("The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.").

In order to establish a *prima facie* case of obviousness, a rejection must satisfy, *inter alia*, at least the following conditions:

1) The prior art reference(s) must teach or suggest all of the elements and limitations recited in the claims; and

2) There must be some suggestion, teaching, or motivation to combine the references on which the rejection is based.

See MPEP 2142.

1) The Cited Documents (Sirimanne and Foerster), Either Alone or in Combination, Fail to Teach or Suggest All of the Elements of Amended Independent Claims 1, 14, and 17

Applicant submits that neither Sirimanne nor Foerster, either alone or in combination, teaches or suggests all of the elements and limitations recited in the amended independent claims 1, 14, and 17.

Sirimanne

For all of the reasons discussed in detail in conjunction with section 2 above, Applicant submits that Sirimanne fails to teach or suggest at least the following limitations of amended independent claims 1, 14, and 17:

a) one or more anchoring devices connected to the body portion and configured to anchor the fiducial apparatus within the tissue of the non-void target region (amended claim 1) / means for anchoring the body portion within tissue of a non-void target region (amended claim 17);

b) the unanchored position permitting the body portion to move within the tissue of the non-void target region (amended claims 1 and 17);

c) the anchored position securing the body portion within the tissue of the non-void target region (amended claims 1 and 17);

d) inserting the fiducial into the tissue of a non-void target region, the fiducial having an anchoring device that anchors the fiducial within the tissue of the non-void target region, the anchoring device being held closed while being inserted into the tissue of the non-void target region (amended claim 14);

and

e) securing the fiducial within the tissue of the non-void target region after the fiducial is inserted into the tissue of the non-void target region, the anchoring device opening after the fiducial has been inserted into the tissue of the non-void target region (amended claim 14).

Foerster

As for Foerster, Foerster is directed to markers for permanently and non-surgically marking tissue. Applicant submits that the Examiner does not state in his Office Action that Foerster teaches or suggests any of the limitations of amended independent claims 1, 14, or 17.

Applicant further submits that Foerster fails to teach or suggest at least the following limitations of claims 1, 14, and 17:

a) one or more anchoring devices connected to the body portion and configured to anchor the fiducial apparatus within the tissue of the non-void target region (amended claim 1) / means for anchoring the body portion within tissue of a non-void target region (amended claim 17);

b) the unanchored position permitting the body portion to move within the tissue of the non-void target region (amended claims 1 and 17)

c) the anchored position securing the body portion within the tissue of the non-void target region (amended claims 1 and 17);

d) inserting the fiducial into the tissue of a non-void target region, the fiducial having an anchoring device that anchors the fiducial within the tissue of the non-void target region, the anchoring device being held closed while being inserted into the tissue of the non-void target region (amended claim 14);

and

e) securing the fiducial within the tissue of the non-void target region after the fiducial is inserted into the tissue of the non-void target region, the anchoring device opening after the fiducial has been inserted into the tissue of the non-void target region (amended claim 14).

Applicant concludes that neither Sirimanne, nor Foerster, either alone or in combination, teaches or suggests all the limitations of claim 1, and/or claim 14, and/or claim 17.

2) There is no Suggestion, Teaching, or Motivation to Combine the Documents (Sirimanne and Foerster) on Which the Examiner's Rejection is Based

It is well known that the cited documents themselves must suggest the desirability of making the proposed combination, in order for a *prima facie* case of obviousness to be established. MPEP §§ 2141 - 2142. In other words, the teaching or suggestion to make the claimed combination (as well as the reasonable expectation of success) must both **be found in the prior art** itself, and not based on applicant's disclosure. MPEP 2142. Also, "[*T*]*he evidence of record must identify an objective*

source of the motivation to combine A with B in the manner proposed." In Re San Su Lee, 277 F.3d 1338 (CAFC 2002). Further, *"[T]he initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done."* MPEP 2142 and In Re San Su Lee, 277 F.3d at 1338.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills,* 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) MPEP2143.01

Applicant respectfully submits that the record does not establish the requisite motivation for combining Sirimanne with Foerster. Nowhere in the Sirimanne and/or Foerster documents themselves is there any suggestion of the desirability of making the proposed combination. Applicant submits that the burden of providing a suggestion of the desirability of making the proposed combination has not been met.

For all of the reasons discussed above, Applicant submits that amended independent claims 1, 14, and 17 are not obvious under 35 U.S.C. § 103 over Sirimanne in view of Foerster.

B. Because Amended Independent Claims 1, 14, and 17 Are Not Obvious Under 35 U.S.C. § 103 Over Sirimanne in View of Foerster, and Because Claims 7-9, 16, and 23-25 Depend on Claims 1, 14, and 17, Respectively, Claims 7-9, 16, and 23-25 Are Not Obvious Under 35 U.S.C. § 103 Over Sirimanne in View of Foerster

It is well known that "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP 2143.03; In re Fine, 837 F.2d 1071, 2 USPQ2s 1596 (Fed. Cir. 1988).

Claims 7-9 all depend on claim 1, and therefore include all the limitations of claim 1. For all the reasons discussed above, amended independent claim 1 is nonobvious

under 35 U.S.C. 103 over Sirimanne in view of Foerster. Accordingly, it follows that claims 7-9 (all depending from claim 1) are also nonobvious under 35 U.S.C. §103.

Claim 16 depends on claim 14, and therefore include all the limitations of claim 14. For all the reasons discussed above, amended independent claim 14 is nonobvious under 35 U.S.C. 103 over Sirimanne in view of Foerster. Accordingly, it follows that claim 16 (depending from claim 14) are also nonobvious under 35 U.S.C. §103.

Claims 23-25 depend on claim 17, and therefore include all the limitations of claim 17. For all the reasons discussed above, amended independent claim 17 is nonobvious under 35 U.S.C. 103 over Sirimanne in view of Foerster. Accordingly, it follows that claims 23-25 (depending from claim 17) are also nonobvious under 35 U.S.C. §103.

For these reasons, it is submitted that claims 7-9, 16, and 23-25 are allowable.

5. Conclusion

On the basis of the foregoing amendments, Applicant respectfully submits that all of the pending claims 1-29 are in condition for allowance. An early and favorable action is therefore earnestly solicited.

Respectfully submitted,

Elizabeth E. Kim

Elizabeth E. Kim, Reg. No. 43,334
McDermott Will & Emery LLP
28 State Street
Boston, MA 02109
(617) 535-4411
(617) 535-3800
E-mail: ekim@mwe.com

Date: March 21, 2005